



APPEAL

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Hiatt

EXAMINER: Craver

SERIAL NUMBER: 09/406,001

ART GROUP: 2685

FILED: 09/24/1999

CASE NO: HTT-9901

ENTITLED: System for Transferring an Address List and Method

Law Office of Dale B. Halling
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June 10, 2002

APPEAL BRIEF TRANSMITTAL LETTER (37 CFR 1.192)

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

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Technology Center 2600

Dear Sir:

Transmitted herewith is an Appeal Brief under 37 CFR 1.192 for the above captioned patent application. The petition fee of \$160.00 required under 37 CFR 1.17(c) is enclosed.

Respectfully submitted,
(Dale Hiatt)

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#18 2063

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT(S): Hiatt EXAMINER: Craver, Charles R.

SERIAL NO.: 09/406,001

ART GROUP: 2685

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Case No.: HTT-9901 JUN 25 2002

Technology Center 2600

ENTITLED: System for Transferring an Address List and Method

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Dale B. Halling

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APPEAL BRIEF

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the final rejection of claims 1-11 & 13-20 of the Office Action dated March 14, 2002. This application was filed on September 24, 1999. Appellant submits this Appeal Brief pursuant to 35 U.S.C. §134 and 37 C.F.R. § 1.192 in furtherance of the Notice of Appeal filed in this case on May 16, 2002. The fees required under 37 C.F.R. §1.17(b) and any other necessary fees are enclose as indicated in the accompanying Appeal Brief Transmittal Letter.

I. Real Party In Interest

The real party in interest is: Aden Dale Hiatt, Jr., the inventor.

II. Related Appeals And Interferences

There are no appeals or interferences related to the present appeal.

III. Status Of Claims

Claims 1-11 & 13-20 (see Appendix) are pending in this application.
Claims 1-11 & 13-20 are rejected and are involved in this appeal.

IV. Status Of Amendments

An after final amendment was filed on April 15, 2002. This resulted in an Advisory Action in which the status of the claims did not change.

V. Summary Of The Invention

The patent application is directed to the problem of exchanging address and telephone lists between the large variety of personal communication devices. These devices include cellular telephones (PCS telephones), pagers and PDA's (Personal Digital Assistants). One of the common situations where this capability is needed, is when a salesman (saleswoman, salesperson) takes over a new territory. The previous salesman has a variety of address and telephone lists in his cellular telephone and PDA. In addition, addresses and telephone numbers may be stored in a personal computer or a centralized database. Presently, the new salesperson is forced to enter this information manually into his cellular telephone, pager or PDA. Another common situation where this invention is needed is for the manual or automatic backup of all these personal communication devices via a wireless signal to telephone central office or similar center. When one of these devices loses its address list it can take up to ten hours to reenter all of the information. A third common need for this invention is to download updated contact lists to a field sales force. Of course some limited capabilities do exist to exchange information such as an infra-red communication link that allows a PDA to share information with a personal computer. As a result, what is needed is a system that transfers an address list between any computer and personal communication device or between personal communication devices. The system should allow the user to initiate the transfer from anywhere the personal communication device is able to obtain normal communication coverage.

Figure 2 (specification) is a schematic diagram of a system 50 for transferring an address list in accordance with one embodiment of the

invention. A portable wireless device, such as a cellular (PSC) telephone 52, PDA (Personal Digital Assistant) 54, portable computer 56 or pager, has a wireless connection 58 to a base station 60. The base station 60 is part of a wireless communication system, such as a cellular (PCS) network, a pager network, or a wireless computer/PDA network. The base station 60 is connected to the public switched telephone network (PSTN) 62. In one embodiment, the PSTN 62 connects directly to a modem of a computer 64. In another embodiment, the PSTN 62 connects to a LAN (Local Area Network) that is connected to the computer 64.

In one embodiment the PSTN 62 connects to an ISP (internet service provider) 66. The ISP 66 provides access to the internet 68. A second ISP 70 is connected to the modem of the computer 64. In another embodiment the internet 68 is connected to a server 72. The server is connected to the computer 64 by a LAN 74.

A user operates the system by selecting an address program on his portable wireless electronic device 52, 54, 56. The program asks him for an electronic address, such as the telephone number of the modem of the computer 64 or the telephone number of his ISP 66 and the URL (universal resource locator) of the computer 64. Note in one embodiment, the server 72 is the main repository of the address lists. In this case the user enters a URL of the server 72. When the user enters the telephone number of the modem of the computer 64, the portable electronic device establishes a wireless connection with the base station 60. The base station establishes a connection with the computer 64 through the PSTN 64. The user then selects an address file to upload (download). In one embodiment, the user can select a plurality of fields for transfer. For instance, a user may only want the names and telephone numbers for his cellular phone even though the computer's addresses includes street addresses and email addresses.

Alternatively the user can connect to the computer 64 or server 72 as if he were connected to a world wide web (WWW) site. In this case the user establishes a connection to his ISP 66 and then enters a URL of the server 72 (computer). The server 72 responds with a web page that included choices such as upload-download, file, fields and selected entries. The user's input is similar to a standard web page with hyperlinks. In this case a digital personal communication system protocol used for the connection 58 encapsulates a wide area network protocol, such as an internet protocol. Note other wide area network protocols are also contemplated by the invention. For instance, the internet protocol encapsulates a HTML (hyper text markup language - hypertext protocol) protocol.

In another embodiment the user sends an email with his request to his ISP. The computer 64 downloads the email and executes the address transfer program based on the information in the email. The response is sent via email to the user. The user's electronic device downloads the response and updates the address file. In this case the digital personal communication system protocol encapsulates the internet protocol and the internet protocol encapsulates the SMTP (Simple Mail Transfer Protocol). Note that other electronic mail protocols could also be used.

The system can also be setup so that there is a transfer between portable wireless electronic devices. In this case the wireless communication system establishes a connection between the two portable wireless electronic devices. This connection may go through the PSTN 62.

In another embodiment the user wants to send updated files from his portable wireless electronic device 52, 54, 56 to his personal computer 64 (or server 72). In this case the user pulls up his address program and selects upload or transfer to computer option. The communication system works similarly to the examples shown above. Note that the address program

includes an updated time stamp. The date stamps of two similar records are compared and the transferred address is only stored if its date stamp is newer than the record already in the file. As a result only new information is stored.

Thus the system allows a user to easily transfer an address list between a computer and personal communication device or between personal communication devices.

VI. Issues

1. Does the examiner have to cite some concrete evidence for his rejections or can the examiner state that the element or steps of in a claim are inherent or assumed to be performed by in the prior art references?

2. Can a reference (Microsoft Publications Q162203 and Q169709) that has a date after the filing date of the application be legally or logically persuasive that a claim in the application is obvious?

3. Miller Reference

a) Antecedent Basis: Since the independent claims 1 and 10 require the plurality of addresses be stored in the address database (or the second address book), can the Miller reference that creates a new database for the addresses render the claims obvious?

b) When the Miller reference does not indicate that it will work in a personal communication device as required by claims 1 & 10, can it render these claims obvious?

4. Whether claims 1-14, 16 & 18-20 are unpatentable over Pepe et al., in view of "Import Personal Address Book (PAB) to Outlook 97" by Grant Miller

5. Whether claims 15 & 17 are unpatentable over Pepe et al., in view of Miller and further in view of Gunluk.

VII. Grouping Of Claims

Claims 1, 2, 4, and 5 form a first group of claims.

Claim 18 is a second group of claims.

Claim 3 is a third group of claims.

Claims 6-9 form a fourth group of claims.

Claims 10, 11, 14 and 16 form a fifth group of claims.

Claims 15 & 17 form a sixth group of claims.

VIII. Argument

1. Does the examiner have to cite some concrete evidence for his rejections or can the examiner state that the element or steps of in a claim are inherent or assumed to be performed by in the prior art references?

In In re Zurko, CAFC, August 2001, Case No. 96-1258b, the CAFC stated that the board's "assessment of basic knowledge and common sense was not based on any evidence in the record" and "the board cannot simply reach conclusions based on its own understanding or experience but must point to some concrete evidence." The Board had argued that the element (trusted path) was inherent or implicit. See also Baltimore & Ohio R.R. v. Aderdeen & Rockfish R.R. CO., 393 U.S. 87, 91-91 (1968) (rejecting a determination of the Interstate Commerce Commission with no support in the record)

In the final rejection (March 14, 2002) claim 1 is rejected based on Pepe et al (USPN 5,742,905) in view of Miller. Pepe et al., describe a personal communication internetworking system. The system provides the network subscriber with the ability to remotely control the receipt and delivery of wireless and wireline voice and text messages. (See Abstract Pepe et al) Miller describes a method for importing a personal address book to Outlook 97, an email client. The examiner's rejection (page 3) states that "the computer may send an address book file via email through the network of Pepe to the wireless user, who may then inset the address book into their email program, inherently storing said address in said address database."

There are a number of problems with the examiner's analogy to the present application. Claim 1 requires a personal communication device,

defined as a cellular telephone, pager or PDA (See Background of Invention, Page 1, lines 11-14). There is no suggestion that Outlook 97 works with any of these products. Second, Miller has the user create a new file (USERNAME.pab), step 2, and then Miller has the attachment stored in the new file at step 5. For more information see "OL97: How to Copy the Personal Address Book to another Computer" Microsoft Product Support Services, Article ID; Q169709, last reviewed November 14, 2000. Page 3 states "8. Restart Outlook. Your new Personal Address Book should now be available." In addition, it states "Note; There is no method for merging one Personal Address Book with another." As a result, the said addresses are stored in a new address database not in said address database. Under the law the examiner must have some concrete evidence for his position. Claim 1 is allowable. Third, the information provided by Miller is extremely vague and limited. Miller never discusses transferring addresses between two devices. The steps outlined by Miller are fairly standard for saving information to a file in a computer.

Claim 3 is rejected based on Official Notice (See Final rejection 3/14/02). Claim 3 requires that the wireless link is a digital personal communication system protocol that encapsulates a wide area network protocol. The rejection states that PCS is a wide area network and "as such the examiner takes Official Notice of such a feature." (Final Rejection 3/4/02) The applicant seasonably traversed the Official Notice, however the examiner never provided a prior art reference or an affidavit in response as required by the MPEP 2144.03. In addition, even if PCS is considered a wide area network the claim requires that the digital personal communication system protocol encapsulate a wide area network protocol. No encapsulation is shown. Claim 3 is allowable.

Claims 6-9 have been rejected based on the statement that "Pepe disclosed a PDA which would inherently contain a program for selecting and transferring the data, as would Outlook." As is clear from the cases above, the examiner must provide some concrete evidence for this assertion. Claims 6-9 are allowable.

Claim 10 is rejected based on Pepe et al., and Miller. However, there are several admitted gaps in these references. For instance, the examiner states in his rejection of this claim that setting up a communication path "inherently comprises the step of selecting or using transfer software to do so." Certainly it would be possible to setup a communications path without inherently selecting an address transfer program as required by step (a) of the claim. Any standard voice telephone call is one example. In rejecting the step of sending addresses between the two devices, the examiner states "it is assumed that the data may comprise any information the user wishes to transfer." The purpose of the application is to send address information and have it easily available in the device requesting the address. Transferring data from one type of system to another type of system and having the data in a form that can be used by the new system is the source of many major information technology projects. The complexity of this step cannot be brushed under the rug with the statement that it is assumed that the data may comprise any information the user wishes. As is clear from the cases above, the examiner must provide some concrete evidence for this assertion. Claim 10 is allowable.

Claim 13 requires selecting a file of address and claim 14 requires selecting a field in file of address. According to the examiner since Miller discloses that said addresses may be in a file, the selection of a field in the file would further have been obvious to one of ordinary skill in the art."

In other words the examiner does not have any concrete evidence, but after reading the application it was obvious to him. This is clearly impermissible. Claims 13 and 14 are allowable.

Claim 18 is rejected based on Pepe et al., and Miller. However, there are several admitted gaps in these references. For instance, the examiner states that "Pepe discloses a method for transferring information from a computer inherently using a program." (Final Rejection Page 7) The claim actually requires address transfer software not just transfer software. The specification is clear that address transfer software is specifically designed to make it easy to transfer addresses between a computer and a personal communication device. There is no mention in Pepe et al., of transferring addresses. It is also clear that it is one thing to transfer a file of addresses, it is another to get those addresses into a usable address database or address book. In addition, the examiner states that Pepe "inherently comprises a step of selecting or using/displaying transfer software." He further states that "it is assumed that the data may comprise any information the user wishes." The purpose of the application is to send address information and have it easily available in the device requesting the address. Transferring data from one type of system to another type of system and having the data in a form that can be used by the new system is the source of many major information technology projects. The complexity of this step cannot be brushed under the rug with the statement that it is assumed that the data may comprise any information the user wishes. Clearly the examiner is missing some concrete evidence for his position as required by the case law cited above. Thus claim 18 is allowable.

2. Can a reference (Microsoft Publications Q162203 and Q169709) that has a date after the filing date of the application be legally or logically persuasive that a claim in the application is obvious?

The filing date of the present application is September 24, 1999. The above referenced publications have the dates of February 22, 2001 (Q162203) and November 14, 2000 (Q169709). The examiner states in the final rejection page 3, "for a more detailed explanation of said process, see "User Profiles and Information Services" and "How to Copy the PAB to Another Computer", Microsoft Publications Q162203 and Q169709." Since the date of these publications is after the filing date, legally these publications are not prior art, 35 USC 103(a). In addition, how can a publication dated after the filing date be used to illuminate what happened before the filing date? By definition these publications may contain material that was not available before the filing date of the present application. Thus the reference of these publications provides no legal or logical support for the examiner's position. It does however, suggest that the examiner is incorrectly reading the information of these publications into the prior art reference, Miller. It also points out that the information provided by Miller is extremely vague and limited. Miller never discusses transferring addresses between two devices. The steps outlined by Miller are fairly standard for saving information to a file in a computer.

It should also be noted that the publication "OL97: How to Copy the Personal Address Book to another Computer" Microsoft Product Support Services, Article ID; Q169709, last reviewed November 14, 2000, at page 3 states "8. Restart Outlook. Your new Personal Address Book should now be

available.” In addition, it states “Note; There is no method for merging one Personal Address Book with another.” As a result, the said addresses are stored in a new address database not in said address database. While this evidence may not be definitive for the applicant, it is logical persuasive in the applicant’s case. Since, the product is unlikely to have fewer features at a later date than at an earlier date.

3. Miller Reference

a) Antecedent Basis: Since the independent claims 1 and 10 require the plurality of addresses be stored in the address database (or the second address book), can the Miller reference that creates a new database for the addresses render the claims obvious?

Antecedent basis requires that if the article “the” is used in front of an element of a claim then this is exactly the same element earlier referred to by the article “a”. See Mechanics of Patent Claim Drafting, (Second Edition) 1978, John Landis, Section 20. As a result, in claim 1 the address database of the personal communication device is that same in which the plurality of addresses are stored. Miller first has the user create a new file (USERNAME.pab), step 2, and then Miller has the attachment stored in the new file at step 5. For more information see “OL97: How to Copy the Personal Address Book to another Computer” Microsoft Product Support Services, Article ID; Q169709, last review November 14,2000. Page 3 states “8. Restart Outlook. Your new Personal Address Book should now be available.” In addition, it states “Note; There is no method for merging one Personal Address Book with another.” As a result, the said addresses are stored in a new address database not in said address database. Note a database is a collection of related information.

Thus a database program may be used to create multiple databases. Clearly, Miller is suggesting that a new database is being created to store the addresses. The same discussion applies to claim 10 except the phrase address list is substituted for address database. Claims 1 and 10 are allowable.

b) When the Miller reference does not indicate that it will work in a personal communication device as required by claims 1 & 10, can it render these claims obvious?

The question of obviousness requires that we determine if the references, taken as a whole, would suggest the invention to one of ordinary skill in the art. *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 220 USPQ 97 (Fed. Cir. 1983). Since Miller relates only to an email program and there is no suggestion that it works with any of the cited examples of a personal communication device (Cellular telephone, pager, PDA - Page 1, lines 11-14 of specification), it cannot be said to render claims 1 and 10 obvious. Claims 1 and 10 both require that the plurality of addresses be stored in the address database (address list) in the personal communication device. Outlook 97 only discusses its use in a standard personal computer. As a result, the suggestion to use Outlook 97 to transfer addresses from a computer to a personal communication device is lacking. Since the personal communication device would have to run Outlook 97 in order to perform the steps of Miller. In addition, the information provided by Miller is extremely vague and limited. Miller never discusses transferring addresses between two devices. The steps outlined by Miller are fairly standard for saving information to a file in a computer. Claims 1 and 10 are allowable.

4. Whether claims 1-11, 13-14, 16 & 18-20 are unpatentable over Pepe et al., in view of "Import Personal Address Book (PAB) to Outlook 97" by Grant Miller

The rejection of claims 1-11, 13-14, 16 & 18-20 relies on multiple references to inherent, assumed, or Official Notice of elements missing in the claims. (See Issue 1 above) The rejection of these claims relies on references that are not prior art under the law and cannot be considered logical persuasive. (See Issue 2 above) The rejection of these claims requires ignoring that the reference Miller creates a new address database. (See Issue 3a above) The rejection of these claims relies on ignoring that Miller does not suggest that Outlook 97 will work with a personal communication device. (See Issue 3b above) The analogy the examiner is attempting to make between the prior art and the present application has numerous inconsistencies. Claims 1-14, 16 and 18-20 are allowable under the law.

Note that claims 2, 5, 11, 14, 16 and 19-20 are allowable as being dependent from an allowable base claim.

5. Whether claims 15 & 17 are unpatentable over Pepe et al., in view of Miller and further in view of Gunluk.

Claims 15 and 17 depend from claim 10. These claims specify that the electronic address is a universal resource locator or an email address. Miller only deals with an email program for a computer. The email address of claim 17 is the email address of the personal communication device. Since Miller does not suggest that it may be used with a personal communication device, it cannot suggest that the personal communication device have an email address. Gunluk describes a short message server for storing short messages on a cellular telephone system.

Nothing in Gunluk would suggest that the personal communication device have an email address. From the above it is clear that none of the references suggest that the electronic address is a universal resource locator. Claims 15 and 17 are allowable.

All groups of claims are allowable.

IX. Appendix Of The Appealed Claims

1. A system for transferring an address list, comprising:

a personal communication device containing an address database;
a wireless communication system capable of establishing a wireless communication link with the personal communication device;
a wireline communication network connected to the wireless communication system; and

a computer connected to the wireline communication network, the computer containing an address software that is capable of extracting a plurality of addresses in an address database and sending the plurality of addresses to the personal communication device, the personal communication device storing the plurality of addresses in the address database of the personal communication device, wherein the computer is not part of the wireline communication network and is not part of the wireless communication system.

2. The system of claim 1, wherein the personal communication device is a cellular telephone.

3. The system of claim 2, wherein the wireless communication link is a digital personal communication system protocol that encapsulates a wide area network protocol.

4. The system of claim 2, wherein the internet protocol encapsulates a hypertext protocol.

5. The system of claim 2, wherein the internet protocol encapsulates an electronic mail protocol.

6. The system of claim 2, wherein the cellular telephone contains an address transfer program.

7. The system of claim 6, wherein the address transfer program requests a telephone number for a transfer.

8. The system of claim 7, wherein the address transfer program requests a file name for the transfer.

9. The system of claim 7, wherein the address transfer program allows a user to select a plurality of address fields for the transfer.

10. A method of transferring an address list, comprising the steps of:

(a) selecting an address transfer program at a first electronic device, the first electronic device is not part of a wireline communication network and is not part of a wireless communication system, the first electronic device containing a first address book;

(b) entering an electronic address of a personal communication device, the personal communication device is not part of the wireline communication network and is not part of the wireless communication system, the personal communication device containing a second address book;

(c) setting up a communication path between the first electronic device and the personal communication device, the communication path including a wireless portion and a wired portion; and

(d) transferring a plurality of addresses from the first address book to the second address book.

11. The method of claim 10, wherein step (d) further includes the step of:

(d1) transferring the plurality of addresses from the personal communication device to the first electronic device.

13. The method of claim 10, wherein step (a) further includes the step of:

(a1) selecting a file of addresses.

14. The method of claim 10, wherein step (a) further includes the step of:

(a1) selecting a field in the file of addresses.

15. The method of claim 10, wherein step (b) further includes the step of:

(b1) entering a universal resource locator.

16. The method of claim 10, wherein step (b) further includes the step of:

(b1) entering a telephone number.

17. The method of claim 10, wherein step (b) further includes the step of:

(b1) entering an email address.

18. A computer-readable program containing computer-readable instructions that when executed by a computer performs the following steps:

(a) displaying an address transfer option that extracts a plurality of addresses from an address database;

(b) requesting an electronic address of an electronic device, when the address transfer option is selected;

(c) establishing a communication link with the electronic device through a communication network; and

(d) receiving the plurality of addresses at the electronic device and storing the plurality of addresses in an address list of the electronic device.

19. The computer-readable program of claim 18, wherein step (b) further includes the steps of:

(b1) selecting a file of addresses.

20. The computer-readable program of claim 18, wherein step (b) further includes the steps of:

(b1) selecting a field of the file of addresses.

Respectfully submitted,
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